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In re Application :
Anderson et al :
Serial No. 09/663,963 :DECISION ON PETITION
Filed: 19 September 2000 :
Attorney Case No. M6560 OS/OAPT :

This is in response to applicants' Petition filed with the certificate of facsimile transmission date of 16 October 2001, for review under 37 CFR 1.144 of the restriction requirement set forth on 18 April 2001 as Paper No 6. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file shows that this application was filed under 35 USC 111(a) on 19 September 2001.

In Paper No. 6, the examiner set forth under 35 USC 121 a restriction requirement between the following groups:

Group I, Claims 1-12 drawn to a culture medium composition,
classified in Class 435, Subclass 253.6.

Group II, Claim 13, drawn to a culture medium composition,
classified in Class 435, 254.2.

Group III, Claims 14-28, drawn to a process to make
polycarboxylic acids wherein the culture media is applied

to cultivate C. tropicalis, classified under Class 435,
subclass 69.9

The Examiner reasoned that Groups I and II were related by a combination/subcombination relationship and both were separate and distinct products. Further, the examiner reasoned that Groups I and II were related to Group III as product and process of using. The examiner further required an election of species irrespective of which Group was elected.

In Paper No. 8, filed 8 May 2001, Applicants elected Group I, with traverse and questioned the requirement for a species election.

In Paper No 9, mailed 8 June 2001, the examiner pointed out that no election of species had been made in paper No. 8.

On 26 June 2001, Applicants discussed the election of species requirement in an interview with Examiner Prats and SPE Wityshyn.

In Paper No. 11 filed 27 June 2001, Applicants elected ammonium sulfate as the inorganic source of nitrogen which reads upon claims 1-3 and 6-12 and calcium as the at least one metal which reads up claims 1-3, 6-7 and 10-12, with traverse.

In Paper No. 12, mailed 17 July 2001, the examiner considered the traversal and made the restriction requirement Final. Claims 4-5, 8-9 and 13-28 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being directed to nonelected claims, there being no allowable generic or linking claim. Claims 1-3, 6-7 and 10-12 were examined on the merits and rejected under 35 USC 102(b) as anticipated by US Patent No. 5,618,708.

In Paper No. 13, filed 16 October 2001, Applicants presented arguments concerning the rejection under 35 USC 102(b). Applicants also filed this petition, which was unfortunately not promptly forwarded to the deciding official.

In Paper No. 14, mailed 31 December 2001, the examiner considered the arguments and made the rejection of claims 1-3, 6-7, 10-12 under 35 USC 102(b) Final.

In Paper No. 15, filed 20 February 2002, Applicants again argued the rejection set forth under 35 USC 102(b).

In Paper No. 16, the examiner set forth an Advisory Action which responded to the arguments and maintained the rejection of claims 1-3, 6-7 and 10-12 under 35 USC 102(b).

In the Petition, Applicants have pointed out that all three Groups are classified in the same class 435. With regards to the restriction between Groups I and II, Applicants argue that all the claimed elements of claim 13 find antecedent basis in claim 1.

Applicants point out that the same carbon, energy and inorganic nitrogen sources are used. Applicants assert that the same holds true of the remaining other ingredients. Applicants argue that claim 13 is a preferred embodiment of the invention of claim 1.

Applicants argue that Groups I-III are all directed to the making of carboxylic acids. Applicants assert that the Examiner has failed to show that the members of the Markush group are unrelated and diverse. Applicants cite MPEP 803.02. Applicants argue that all members of the Markush Groups (1) share a common utility and (2) share a substantial structural feature.

A Notice of Appeal was filed 27 March 2002.

DISCUSSION

The Petition and the file history have been considered carefully.

Concerning the classification of the groups, all three Groups were placed in Class 435, however each Group was placed in a separate subclass. Group I was placed in subclass 253.6, which covers culture media per se, for bacteria or actinomycetales. Group II was placed in subclass 254.2, which covers media for transformed yeast/fungi. Nothing in the claims 1-13 refers to the type of organism cultured in the culture media. Moreover, a product claim is primarily searched on the composition or structure of the products, which in this case, is the constituents in the media culture, and not on the product's intended use. Both Groups I and II could have been classified in either subclass.

Independent claim 15 recites culturing the yeast strain *C. tropicalis*. Group III was appropriately placed in subclass 69.9, which covers recombinant DNA techniques for making proteins or polypeptides using signal sequences derived from yeast.

Concerning the reason provided for restriction between Groups I and II, both combination/subcombination and election of species were set forth. Claim 13 was described as both a subcombination of Group I and as a generic claim, grouped together with Group I, reciting same groups of species.

Applicants have persuasively argued that claim 13 is a preferred embodiment of Claim 1. Claim 13 recites a fermentation medium comprising the carbon source of claim 2, an inorganic nitrogen source of ammonium, as in claims 3 and 4, a phosphate and potassium source as recited in claim 6, a magnesium source and metal (calcium) source as recited in claims 7, 8 and 9, a chelating agent as recited in claim 11 and a trace metal as recited in claim 12.

There are only two significant differences between independent claims 1 and 13. Claim 1 requires a source of biotin that is not specifically recited in claim 13. Claim 13 recites an iron salt, which, though not specifically recited in claim 1, is encompassed by claim 1, part (d), in the phrase "at least one metal." All of Claims 1-13 are drafted in open claim

language “comprising” which allows for the additional of other constituents, such as biotin or iron.

Thus, Groups I and II should not be restricted as combination and subcombination and are being rejoined.

With regard to the election of species, claims 1-13 are directed to a fermentation media comprising combinations of ingredients selected from several different Markush groups. The request for a species election set forth in the restriction requirement was proper. Applicants elected a particular combination of ingredients for examination. Markush Practice is discussed in MPEP 809.02(a) and says in part:

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Thus MPEP 809.02(a) provides Applicants with two approaches to having more than one species examined. If the generic claim is found allowable, Applicant will be entitled to consideration of additional species. Alternatively, if applicants admit on the record that the species are obvious variants of one another, the species will be examined together, with the caveat that art on one species may be applied to the others under 35 USC 103(a), in view of applicants admission.

With regard to the restriction between the product of Group I and the method of Group III, the Examiner appropriately restricted between the product and its method of use. The product has been elected for examination. The product claims are properly withdrawn from consideration as being directed to non-elected inventions. Applicant is reminded of rejoinder practice. See MPEP 821.04 which says in part:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if

applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

If the product of Group I is found to be allowable, and if the claims of Group II, the method of using the product, were amended to include all the limitations of the allowable product, the dependent method claims will be rejoined.

DECISION

Applicants' petition is **GRANTED IN PART** for the reasons set forth above.

Applicants remain under obligation to properly respond to file an Appeal Brief in accordance with the time period set in 37 CFR 1.192(b).

Any request for reconsideration of this decision must be made by way of a renewed petition and must be filed within TWO MONTHS of the date of mailing of this decision in order to be considered timely.

Should there be any questions with respect to this decision, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, Washington DC 20231. Alternatively, SPRE Burke can be reached by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.



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